

Use is ACTUALLY Measured by Benefit

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Addressing whether a service mark owner had established a protectable interest in his marks through actual or analogous use, the US Court of Appeals for the 10th Circuit reversed in part the district court's grant of summary judgment for the alleged infringer, explaining that by focusing on sales, the district court applied the wrong legal standard for analyzing actual use. *Underwood v. Bank of Am. Corp.*, Case Nos. 19-1349, 20-1087 (10th Cir. Apr. 30, 2021) (Matheson, J.)

In 2010, Erik Underwood and My24HourNews.com (collectively, Underwood) applied for, and were granted, registration of a service mark in Georgia for a computer-animated woman named Erica who verbally reports the news through cell phones and computer programs. In 2012, Underwood registered the domain name for a website, my24erica.com. On the website, E.R.I.C.A. could answer questions and offer recommendations regarding movies and television shows. In 2016, Bank of America filed an intent to use application with the US Patent and Trademark Office for ERICA, a mark for goods and services including voice-controlled information, personal assistant banking and finance services. Underwood sued Bank of America, alleging common law service mark infringement of two marks, E.R.I.C.A. and my24erica.com.

The district court granted summary judgment for Bank of America, concluding that Underwood had not established a protectable interest in either of the marks through actual or analogous use. Underwood appealed.

The 10th Circuit concluded that the district court applied the wrong legal standard and committed two legal errors in its analysis of the issue of actual use of the E.R.I.C.A. mark. First, the district court erred by assuming that in order to establish actual use, Underwood's customers must have purchased the services offered or Underwood must have generated revenue, because actual use is measured by benefit—not sales to third parties. Second, the district court erred by limiting the services at issue to those listed on the Georgia registration (*i.e.*, newscasting). Instead, the district court should have considered *all* services identified by the mark, including those on the my24erica.com website (*i.e.*, search engine and personal assistant services). The Court remanded the issue of actual use to permit the district court to address the factual issues under the correct legal standard.

Analogous use of a mark is use in commerce that is non-transactional, *e.g.*, promotional efforts for the goods or services, such as advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications. Although actual use need not have a substantial impact on the purchasing public, analogous use must be “of such a nature and extent as to create public

identification of the target term with the [user's] product or service.” To qualify as analogous use, the use must be open and notorious, *i.e.*, “of such a nature and extent that the mark has become popularized in the public mind so that the relevant segment of the public identifies the marked goods with the mark’s adopter.” Because the analogous use in terms of the E.R.I.C.A. mark had large gaps in time; consisted only of PowerPoint presentations at business meetings, use on business cards and on promotional DVDs; and was known only to a small handful of industry actors, the Court affirmed the district court’s grant of summary judgment on the issues of analogous use.

Practice Note: When arguing actual use, keep in mind that actual use is measured by benefit—not sales.

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